

REMARKS

Claims 1-18 are now active in this application.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claims 6, 8, 9 and 17 are rejected under 35 U.S.C. §102(e) as being anticipated by Flores et al. (hereinafter, Flores).

The rejections are respectfully traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention such that the identically claimed invention is placed into possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). There is a significant difference between the claimed invention and the apparatus disclosed by Flores, that scotches the factual determination that Flores identically describe the claimed inventions within.

Independent claim 6 requires, *inter alia*:

wherein, in a case where the prescribed mode is set, said controller controls said translating means so as to translate the document data including a plurality of languages into at least one language, and controls said output unit so as to output the translated document data.

Independent claim 17 requires, *inter alia*:

wherein said controller controls said translating means so as to translate a first document data written in a first language and a second document data written in a second language into at least one language, and controls said output unit so as to output the translated first and second document data.

As shown in Figs 4 and 5 of the present application, the original group consisting of the first page (language A), the second page (language B) and the third page (language C) can be outputted as images of the first to third pages (all of them are language A).

Clearly, independent claims 6 and 17 each require a controller to control the translating means so as to translate document data into a language.

Flores does not disclose or suggest such a controller. Flores discloses that an original contained in a work is translated into a plurality of languages and the translated languages are registered as a data base 16. Flores discloses further that a certain language text selected by a user is read out from the data base 16 and then displayed on a display panel (see Fig. 5A).

Thus, Flores merely discloses creating a database of both an original document (as a text of language 1) and of translations of the original document (second, third, etc. language as the methodology of FIG. 4 illustrates). As described at column 6, lines 48-57:

A user will generally choose to view a work in the written text of two or more languages presented adjacently (See FIG. 5A). ***Once the user has selected the work the user wishes to view and has chosen the languages the user wishes to view the work in, the accessing program or device will retrieve the chosen texts and display them on the user's monitor.*** This type of adjacent text presentation may be particularly helpful to users or students familiar with one language and attempting to learn or strengthen their reading and/or writing skills or understanding in a second language. (emphasis added)

There is clearly no controller in Flores that controls a translating means so as to translate document data into a (selected) language, as the user merely selects from the database of stored texts that which he wishes to view. This type of system requires a very larger database to store all of the text that can be selected to be viewed. In contrast, the present invention needs no database to store a large volume of (translated) text that can be then selected to be view. More specifically, the present invention has a controller that controls a translating means so as to translate the document data including a plurality of languages into at least one language, and

controls an output unit so as to output the translated document data. Such a system is more efficient than that disclosed in Flores.

The above argued difference between the claimed apparatus vis-à-vis the apparatus of Flores undermines the factual determination that Flores identically describes the claimed inventions within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of independent claims 6 and 17, and claims 8 and 9 depending from claim 6, under 35 U.S.C. § 102 for lack of novelty as evidenced by Flores, is not factually or legally viable and, hence, solicit withdrawal thereof.

II. Claims 1-5, 7, 10-16 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Flores in view of Fujisawa et al. (hereinafter, Fujisawa) and further in view of Miyahara et al. (Miyahara).

The rejections are respectfully traversed.

As noted above, Flores discloses that original contained in a work is translated into a plurality of languages and the translated languages are registered as a data base 16, and that a certain language text selected by a user is read out from the data base 16 and then displayed on a display panel (see Fig. 5A).

Fujisawa discloses an image forming apparatus equipped with a translation function. According to this function, as shown in Fig. 12, a document to which a translated word is attached can be outputted. However, Fujisawa has no description regarding an output sorting.

Claim 1 includes, *inter alia*, the following specific features:

wherein, in a case where the first mode is set, said controller controls said translating means so as to translate the document data into a plurality of

languages, and controls said output unit so as to output the translated document data by same language group, and

wherein, in a case where the second mode is set, said controller controls said translating means so as to translate the document data into a plurality of languages, and controls said output unit so as to output the translated document data by group including each translated language document data.

Independent claim 11 requires, *inter alia*:

wherein said controller controls said translating means so as to translate each of the first document data and the second document data into a first language and a second language, and controls said output unit so as to output the first and second document data translated into the first language as a first group and the first and second document data translated into the second language as a second group.

Independent claims 14 has similar recitations. Thus, independent claims 1, 11 and 14 have a controller which is similar to the controller recited in independent claims 6 and 17, discussed above. Thus, independent claims 1, 11 and 14 are patentable over Flores for the same reasons as are independent claims 6 and 17.

Furthermore, as shown in Figs 2 and 3 of the present application, in the first mode a plurality of translated language document data are outputted by same language group, and in the second mode a plurality of translated language document data are outputted by group including each translated language document data. None of the applied prior art references discloses or suggests that translated language document data are outputted by group.

The Examiner relies upon Miyahara as disclosing sorting and/or grouping of output documents, referring to FIG. 2 and sorter 22. Furthermore, the Examiner asserts that it would have been obvious to one skilled in the art at the time of the invention to modify Flores' method to include Fujisawa's method of outputting and to further include Miyahara's method for sorting and/or grouping, for the purpose of providing an organized method for the translated document.

Miyahara discloses a function which optimizes an image layout by specifying a direction of an original. Fig. 2 discloses a sorter. However, Miyahara is silent about a translation and provides no details as to how documents are sorted by sorted 22. Since Miyahara has no description regarding a document translation, there is no realistic motivation that would impel a person of ordinary skill in the art to apply the teaching of Miyahara to the arrangement of Flores, and in particular, which would motivate a person of ordinary skill in the art:

where document data is translated into a plurality of language, output the translated document data by same language group, and or output the translated document data by group including each translated language document data (claim 1);

where first and second document data are translated first and second languages, output the first and second document data translated into the first language as a first group and the first and second document data translated into the second language as a second group (claim 11); and

where document data is translated into a first language and a second language, output the document data translated into the first and second languages as a single group by the number to be output set by said operation unit (claim 14).

More specifically, the only apparent motivation of record for the modification suggested by the Examiner to arrive at the claimed inventions is found in Applicants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. §103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987).

Thus, independent claims 1, 11 and 14 are patentable over Flores for reasons in addition to the reasons as why independent claims 6 and 17 are patentable over Flores, even when considered in view of Fujisawa and Miyahara. As independent claims 1, 6, 11, 14 and 17 are patentable over Flores, considered alone or in combination with Fujisawa and Miyahara, claims

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2-5 depending from claim 1, claims 7 and 10 depending from claim 6, claims 12 and 13 depending from claim 11, claims 15 and 16 depending from claim 14, and claim 18 depending from claim 17, are patentable over Flores, Fujisawa and Miyahara also.

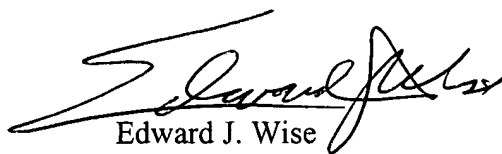
CONCLUSION

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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